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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,331	07/18/2003	Robert A. Cordery	F-726	4828
7590 05/13/2004			EXAMINER	
Charles R. Malandra, Jr. Pitney Bowes Inc. Intellectual Property and Technology Law Dept 35 Waterview Drive, P.O. Box 3000 Shelton, CT 06484			COSIMANO, EDWARD R	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,331

Applicant(s)

CORDERY ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/11/04</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and

C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.

2. The use of various trademark "IntelliLink™" in paragraph number 8 has been noted in this application. Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

2.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The disclosure is objected to because of the following informalities:

A) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 540 of fig. 5 as fig. 5 is described in paragraph number 40;
and

(2) how the program proceeds after box(es):

(a) step 128 of fig. 3 if the inquiry is "NO" as fig. 3 and this step are described in paragraph number 36.

In this regard, it is noted that merely mentioning either a feature or a number with out mentioning the device or operation or number or feature relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

B) the following errors have been noted in the specification:

(1) patent number 6,643,133 as disclosed in paragraph number 5 is incorrect since this patent is not directed to collecting information in a shipping system.

(2) patent number 6,138,108 as disclosed in paragraph number 8 does not exist.

(3) as can be seen in fig. 5 and from the context of paragraph number 40, at line 13, the phrase "520, the meter completes the accounting for the resulting transactions. The" should be --540, the meter completes the accounting for the resulting transactions. The--.

(4) at page 26, line 1, "What is claim d is:" should be --What is claimed is:--.

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

5. Claims 5 & 6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.1 In regard to claim 5:

A) since claim 1 is a system/apparatus claim, the inclusion of method/process claim 5 by dependency creates a confusing hybrid claim, since it is unclear whether the claim 5 is to be considered a system/apparatus claim or a method/process claim; and

B) the subject matter of claim 5 lacks antecedent basis in claim 1, since claim 1 fails to recite the process of accounting for any planned event as recited as a feature of the invention.

5.2 In regard to claim 6:

A) since claim 1 is a system/apparatus claim, the inclusion of method/process claim 6 by dependency creates a confusing hybrid claim, since it is unclear whether the claim 6 is to be considered a system/apparatus claim or a method/process claim.

B) the subject matter of claim 6 lacks antecedent basis in claim 1, since claim 1 fails to recite the processes of either:

(1) detecting that any feature of the invention has either occurred or not occurred, or

(2) sending a message; or

(3) accounting for any feature of the invention that has not occurred.

5.3 In view of the above, should "3" be --4--, at line 1 of claims 5 & 6.

5.4 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6.1 Claims 1-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sansone et al (5,019,991).

6.1.1 In regard to claims 1-4 & 7, Sansone et al ('991) discloses processing a batch of mail by a postal infrastructure, that is the post office, in order to certify that the correct amount of

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postage for the items of mail in the batch has been applied to the mail prepared by a mailer. To this end, a mailer using a mailer system would prepare items of mail with certain preplanned events in mind, where the preplanned events include, for example one or more of the following:

- A) the mail is sorted by zip code or carrier route; or
 - B) the size of the mail batch meets bulk mail requirements; or
 - C) the mail includes barcodes zip codes; or
 - D) the mail has meet the requirements of being bundled or trayed; or
 - E) the mail is part of a drop shipment;
- etc.

Based on the applicable preplanned events, the mailer creates a batch of mail that the mailer believes that each item of mail in the batch will meet the requirements of the post office and hence qualify for receiving a discounted postage rate for the batch. Based on this belief, the mailer would apply the appropriate amount of discounted postage to each of the items of mail in the batch. After the batch of mail has been completed, the mailer would appropriately introduce the mail into the postal infrastructure, that is the post office, with any necessary documentation of the preprocessing performed by the mailer as a request for receiving a discounted postage rate for each item mail in the batch of mail.

6.1.2 Once the batch of mail has entered the post office, the post office scans either (A) the submitted documentation/statement/manifest for the batch of mail, or (B) the items of mail themselves, in order to determine is the mail is being submitted in accordance with one or more of the planned events. The post office determines if a planned event has occurred, by processing each item of mail in the batch of mail to determine if each item in the batch of mail and hence the batch of mail has the correct amount of applied postage would meet the requirements of the post office for the mailer to qualify to receive the applied reduced postage rate for each item in the batch of mail. Where if the determination of the post office in regard to the items of mail in the batch of mail shows that the mailer is not qualified for the reduced amount of applied postage, then the post office would adjust the applied postage by applying the correct amount of postage to each of item of mail in the batch of mail.

6.1.3 As is common practice, the post office requires that mailers prepaid for the correct amount of postage that is required to be applied to an item of mail, hence it would have been inherent to one of ordinary skill at the time the invention was made that the system of Sansone et al ('991) that the post office would appropriately notify the mailer and meter of any additional required postage value that has been applied to the items of mail, so that the additional postage would be properly accounted for by the mailer and meter and post office would not process any mail that has not been properly accounted for by the mailer and meter. It is further noted that for the mailer to be notified, the post office must have access to a mailer/meter database so that the correct mailer/meter is charged for the additional postage value that has been applied to the items of mail

7. The examiner has cited prior art of interest, for example:

A) Le Carpentier (4,752,950), which discloses the remote monitoring and control of postage meters connected to a network.

B) either Barns-Slavin et al (5,072,397 or 5,995,950) or the LI Business News article or Dlugos (5,444,630) or Korowonty (5,475,903), which disclose the application of postage rate discounts to item based on whether or not the items meet the qualifications for the discounts.

C) Connell et al (5,229,932), which discloses producing documentation that the items of mail in a batch of mail meet the readability and physical requirements/qualifications for the application of postage rate discounts to item based on whether or not the items meet the qualifications for the discounts.

D) Mary et al (EP 1113376), which discloses scanning information from items of mail and storing scanned information for the item of mail in a data base.

E) Pintsov et al (6,532,542), which discloses applying an indication of special services to an item of mail.

F) Kovlakas (6,592,027), which disclose refunding a mailer for unusable postage.

8. Applicant must supply prior art listed in paragraphs numbers 8 & 10;

A) patent number: 6,138,108; and

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B) non patent literature: the "November 1999 GAO report".

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783.

The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

04/24/04



Edward R. Cosimano
Primary Examiner A.U. 3629